

REMARKS

In response to the Office Action dated December 18, 2002, the Applicant has amended the application. Claims 1, 7-12, 15, 17, 19, 23, and 25 have been amended to clarify the invention. Claims 2, 3, 5, 6, 13, 14, 18, 20-22, 24, and 26-31 have been cancelled, and claims 32-48 have been added to further define the invention. Claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 are now pending in the application.

Applicant hereby requests further examination and reconsideration of the application, in view of the foregoing amendments and the following remarks. In Paragraph 4 of the Office Action, the Examiner rejected claims 1-3, 5-16, and 27-31 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Raith (US 6,493,550). In Paragraph 5 of the Office Action, the Examiner rejected claims 17-26 under 35 U.S.C. §103(a) as being unpatentable over Grube et al. (US 5,666,661) in view of Lachance (US 6,246,882) and Raith (US 6,493,550). While the application has been amended, Applicant respectfully submits that the combination of these references fails to establish a *prima facie* case of obviousness concerning the invention disclosed by Applicant for the grounds provided below and that the Examiner's rejection should be withdrawn. See M.P.E.P. § 2142 (8th ed. 2001).

The Examiner has combined the Grube and Raith references. However, the two references are not combinable. Grube discloses a communication system where a communication can be switched from a system mode of operation to a direct mode of operation when the distance relationship between the units involved in the communication is obtained, at Abstract. A communication resource controller determines the geographic separation of the units, at column 2, lines 53-67. When the desired distance relationship is met, the communication resource controller transmits a mode change message to the units to switch communication modes, at column 2, lines 20-23. The intended purpose and function of the invention is to allow two mobile units to communicate directly with each other when they are within a certain distance of each other to minimize the use of communication system resources, wherein the distance is determined by a resource controller. Raith concerns the use of a proximity detector to recognize the presence of a private radiocommunication system, Abstract. A proximity system emits a signal for detection by a mobile station, column 3, lines 12-14. The signal is emitted in order to assist a mobile station in switching from a public radiocommunication system to a private radiocommunication system, column 3, lines 12-27. The invention disclosed in Raith concerns the type of communication system utilized by a mobile unit, and requires the use of a proximity system and signal to alert the mobile unit that a stationary private communication system is available. Raith does not concern facilitating direct communication between two mobile units to minimize the use of system resources on a communication system; Raith concerns locating a private communications system to begin using the resources of another communication system. Raith has nothing to do with minimizing the use of system resources. Therefore, the combination of Grube and Raith would destroy the intended purpose and function of the invention disclosed in Grube and is not proper. A *prima*

facie case of obviousness, therefore, cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

There is also no basis to combine or modify the Grobe and Raith references. The prior art does not suggest the desirability of the combination. See M.P.E.P. § 2142 (8th ed. 2001); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). One of ordinary skill in the art would not have found it obvious to combine the teachings of Grube and Raith at the time the invention was made. See *In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987). Grube discloses an invention to encourage direct communication of mobile units in order to conserve the system resources that are available on a communications network. Raith concerns the location and use of a private communications network versus a public communications network. The invention disclosed by Grube seeks to avoid using system resources while the invention in Raith seeks to assist in using the resources of another system. There would be no motivation to modify the invention as described in Grube that encourages direct communication between mobile units to incorporate the invention described by Raith that seeks to encourage the use of resources on another system. For these reasons, the combination of Grobe and Raith cannot be properly made and a *prima facie* case of obviousness cannot be established.

Likewise, there is no basis to combine or modify the Grobe and Lachance references. The prior art does not suggest the desirability of the combination. See M.P.E.P. § 2142 (8th ed. 2001); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). One of ordinary skill in the art would not have found it obvious to combine the teachings of Grube and Lachance at the time the invention was made. Lachance discloses a system and method for tracking items using an item identifier, at column 1, lines 52-58. When an item is moved past a handling zone, an item identification reader detects the item identifier and utilizes a mobile station to the tracking system, at column 1, lines 58-67. The invention disclosed in Lachance does not concern encouraging direct communication between mobile units. Lachance concerns tracking items and relaying that information to a database using a cellular network. There would have been no motivation to modify the invention as described in Grube that encourages direct communication between mobile units to incorporate the tracking system described by Lachance. For these reasons, the combination of Grobe and Lachance cannot be properly made and a *prima facie* case of obviousness cannot be established.

The application as amended now contains four independent claims: 1, 11, 17, and 23. With regard to claim independent claim 1 as amended, Grube, nor Grube in view of Raith, nor Grube in view of Lachance and Raith teach a method of generating a control signal comprising the steps of: determining the location of a first mobile radio terminal; determining the location of a second mobile radio terminal, wherein the second mobile radio terminal permits operation of the first mobile radio terminal only when the first mobile radio terminal and the second mobile radio terminal are either within, or separated by, a specified distance; comparing the locations of the first mobile radio terminal and the second mobile radio terminal; and generating a control signal in response said comparing, wherein the control signal is an activation signal that activates

the first mobile radio terminal if the locations of the first mobile radio terminal and the second mobile radio terminal are within a specified distance.

With regard to claim independent claim 11 as amended, Grube, nor Grube in view of Raith, nor Grube in view of Lachance and Raith teach a method of generating a control signal comprising the steps of: determining the location of at least two mobile radio terminals; comparing at least one of: the specific location of the at least two mobile radio terminals to at least one predetermined location, and the specific location of the at least two mobile radio terminals and time to at least one predetermined location and time; and generating a control signal in response said comparing, wherein the control signal may enable or inhibit a wide variety of applications.

With regard to claim independent claim 17 as amended, Grube, nor Grube in view of Raith, nor Grube in view of Lachance and Raith teach a method of generating a control signal comprising the steps of: receiving, at a location server, an initiation signal from a first mobile radio terminal, said initiation signal including the location of the first mobile radio terminal; transmitting, by the location server, a location query to a second mobile radio terminal; reporting, by the second mobile radio terminal, the location of the second mobile radio terminal in response to the location query; comparing, at the location server, the locations of the first and second mobile radio terminals; and generating a control signal based upon said comparing and transmitting the control signal from the location server to the first mobile radio terminal to active the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are either within, or separated by, a specified distance.

With regard to claim independent claim 23 as amended, Grube, nor Grube in view of Raith, nor Grube in view of Lachance and Raith teach a method of generating a control signal comprising the steps of: receiving, at a location server, an initiation signal from a first mobile radio terminal; transmitting, by the location server, a location query to the first mobile radio terminal and a second mobile radio terminal; reporting, by the first and second mobile radio terminals, respective locations of the first and second mobile radio terminals in response to the location query; comparing, at the location server, the received locations of the first and second mobile radio terminals; and generating a control signal based upon said comparing and transmitting the control signal from the location server to the first mobile radio terminal to activate the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are either within, or separated by, a specified distance.

For the foregoing reasons, Applicant respectfully submits that independent claims 1, 11, 17 and 23, and the claims that are dependent therefrom, are not taught by Grobe, Raith, or Lachance and are patentable over Grube in view of Raith and Grube in view of Lachance and Raith.

Applicant hereby requests further examination and reconsideration of the application, in view of the foregoing amendments and remarks.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was a narrowing amendment made to distinguish over a specified reference or references.

The Commissioner is hereby authorized to charge payment of any additional filing or application fees associated with this communication or credit any overpayment to Deposit Account No. 13-4365.


Attached hereto is a marked-up version of the changes made to the claims by the current amendments. The attached page is captioned "Version with markings to show changes made."

Applicant believes the foregoing amendments place the application in condition for allowance. Entry of the amendments and allowance of the application at an early date is respectfully requested.

For the foregoing reasons, the Applicant respectfully submits that claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 are now in condition for allowance. Reconsideration and withdrawal of the rejection is requested. Allowance of claims 1, 7-12, 15-17, 19, 23, 25, and 32-48 at an early date is respectfully requested.

If the Examiner has any questions about the present Amendment or anticipates finally rejecting any claim of the present application, a telephone interview is requested.

Respectfully submitted,



Charles L. Evans
Attorney for Applicant
Registration No. 40,380
Moore & Van Allen PLLC
2200 West Main Street, Suite 800
Durham, NC 27705
Telephone: (919) 286-8000
Facsimile: (919) 286-8199

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE ABSTRACT

Claims 2, 3, 5, 6, 13, 14, 18, 20-22, 24, and 26-31 have been deleted.

Claims 32-48 were added.

Claims 1, 7-12, 15, 17, 19, 23, and 25 were amended.

1. (Thrice amended) A method of generating a control signal comprising the steps of:
 - determining the location of a first mobile radio terminal;
 - determining the location of a second mobile radio terminal, wherein the second mobile radio terminal permits operation of the first mobile radio terminal only when the first mobile radio terminal and the second mobile radio terminal are either within, or separated by, a specified distance;
 - comparing the locations of the first mobile radio terminal and the second mobile radio terminal[terminals]; and
 - generating a control signal in response said comparing, wherein the control signal is an activation signal that activates the first mobile radio terminal if the locations of the first mobile radio terminal and the second mobile radio terminal are within a specified distance[based upon said comparison;
 - wherein the first mobile radio terminal comprises a mobile communication device and the second mobile radio terminal comprises a key permitting operation of the mobile communication device, and wherein the step of generating a control signal based upon said comparison comprises the step of generating a mobile communication device activation signal].

7. (Once amended) The method of claim 1, wherein the first mobile radio terminal and the second mobile radio terminal[terminals] operate in a

wireless communications system including a base station and a location server communicating therewith[, and wherein the comparing and generating steps are performed at the location server].

8. (Once amended) The method of claim 1, wherein at least one of the determining, comparing, and generating steps are performed by[at one of] the first [and second]mobile radio terminal[terminals].

9. (Once amended) The method of claim 1, wherein the determining steps are performed by using at least one of[locations of the first and second mobile radio terminals are determined by either] a global positioning system and[or] a cellular positioning system[, or a combination thereof].

10. (Twice amended) The[A] method of claim 1, [generating a control signal comprising the steps of:

determining the location of a first mobile radio terminal;

determining the location of a second mobile radio terminal;

comparing the locations of the terminals; and

generating a control signal based upon said comparison;]

wherein the comparing step further comprises the step of comparing a current time with a preselect time.

11. (Once amended) A method of generating a control signal comprising the steps of:

determining the location of at least two mobile radio terminals;

comparing at least one of: the specific location of the at least two mobile radio terminals to at least one predetermined location, and the specific location of the at least two mobile radio terminals and time to at least one predetermined location and time; and

generating a control signal in response said comparing, wherein the control signal may enable or inhibit a wide variety of applications[The method of claim 10, wherein the generating step comprises the step of generating a control signal if the first mobile radio terminal is at a first specified location, the second radio terminal is at a second specified location and the current time matches the preselect time].

12. (Once amended) The method of claim 11, wherein the at least two mobile radio terminals comprise[A method of generating a control signal comprising the steps of:

determining locations of] N mobile radio terminals, wherein $N \geq 2$, the comparing step comprises [;]

comparing the locations of the N mobile terminals with M different specified locations, wherein $M \leq N$, [;] and

the generating step comprises generating[, in response to said comparison,] a control signal if at least one of the N mobile radio terminals is located at each of the M different specified locations.

15. (Once amended) The method of claim 11, wherein the at least two mobile radio terminals comprise[A method of generating a control signal comprising the steps of:

determining locations of] N mobile radio terminals, wherein $N \geq 2$, the comparing step comprises [;]

comparing the locations of the N mobile radio terminals with N specified locations assigned to each of the N mobile radio terminals, [;] and

the generating step comprises generating[, in response to said comparison,] a control signal if each of the N mobile radio terminals is located at its assigned location.

17. (Thrice amended) A method of generating a control signal comprising the steps of:

receiving, at a location server, an initiation signal from a first mobile radio terminal, said initiation signal including the location of the first mobile radio terminal;

transmitting, by the location server, a location query to a second mobile radio terminal;

reporting, by the second mobile radio terminal, the location of the second mobile radio terminal in response to the location query;

comparing, at the location server, the locations of the first and second mobile radio terminals; and

generating a control signal based upon said comparing and transmitting the control signal from the location server to the first mobile radio terminal to active the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are either within, or separated by, a specified distance[comparison;

wherein either the first mobile radio terminal or the second mobile radio terminal comprises a mobile communication device, wherein the corresponding second or first mobile radio terminal comprises a key permitting operation of the mobile communication device, and wherein the step of generating a control signal based upon said comparison comprises the step of generating a control signal activating the mobile communication device for use].

19. (Once amended) The method of claim 17[18], wherein the first mobile radio terminal comprises a mobile communication device, and wherein the second mobile radio terminal comprises a key that may alternatively activate, deactivate, lock, and unlock[permitting operation of] the mobile communication device only when the locations of the mobile communication device and the key are within the specified distance.

23. (Thrice amended) A method of generating a control signal comprising the steps of:

receiving, at a location server, an initiation signal from a first mobile radio terminal;

transmitting, by the location server, a location query to the first mobile radio terminal and a second mobile radio terminal;

reporting, by the first and second mobile radio terminals, respective locations of the first and second mobile radio terminals in response to the location query;

comparing, at the location server, the received locations of the first and second mobile radio terminals; and

generating a control signal based upon said comparing and transmitting the control signal from the location server to the first mobile radio terminal to activate the first mobile radio terminal for use if the locations of the first and second mobile radio terminals are either within, or separated by, a specified distance[comparison;

wherein either the first mobile radio terminal or the second mobile radio terminal comprises a mobile communication device, wherein the corresponding second or first mobile radio terminal comprises a key permitting operation of the mobile communication device, and wherein the step of generating a control signal

based upon said comparison comprises the step of generating a control signal activating the mobile communication device for use].

25. (Once amended) The method of claim 23[24], wherein the first mobile radio terminal comprises a mobile communication device, and wherein the second mobile radio terminal comprises a key that may alternatively activate, deactivate, lock, and unlock[permitting operation of] the mobile communication device only when the locations of the mobile communication device and the key are within the specified distance.